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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,016	07/24/2003	Marco Vignaroli	Z01-136	9957

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EXAMINER

JOHNSON, STEPHEN

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 07/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/626,016	Applicant(s) VIGNAROLI ET AL.	
	Examiner Stephen M. Johnson	Art Unit 3641	<i>MW</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 12-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-17 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/24/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. Applicant's election without traverse of species A (illustrated in figs. 1-5) in the reply filed on 6/30/2004 is acknowledged.

Claims 12-17 are withdrawn from consideration as being directed to non-elected species. Note that the language in claim 12 directed to "a contoured member that protrudes from the base and has an enlarged head that is suitable to be inserted in a corresponding seat formed in the stock of a rifle" is directed to the species illustrated in figs. 6-7.

Claims 1-11 read on elected species A and an action on these claims follows.

2. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 1, use of the phrase "particularly for firearms" makes the claim indefinite as to whether or not firearms must in fact be used to infringe the claims. In claims 5, 7, and 9, what the term "it" is intended to reference is indefinite. In claim 5, the phrase "the butt plate" lacks an antecedent.

3. The term "high" in claims 3 and 5 is a relative term which renders the claim indefinite. The term "high" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The claim is indefinite as to what densities would or would not be of an amount to be considered to be high. What high relative to one density might be considered low relative to another higher density.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Seehase.

Seehase discloses a recoil pad comprising:

- a) a plastic base; 18; col. 5, lines 23-27
 - b) a rear member of deformable material; and 12; col. 2, lines 21-68
 - c) said rear member has a deformability that can vary col. 4, lines 5-8
- according to degree of absorption of the recoil energy.

With regard to claim 4, note that claim limitations directed to the way in which an article is made are not limiting in the confines of an apparatus claim.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seehase in view of Cook.

Seehase applies as previously recited. However, undisclosed is an elastomeric plate that is polyurethane gel. Cook teaches an elastomeric plate that is a polyurethane gel. Cook explicitly encourages substituting one material type for another in an analogous art setting (see col. 4, lines 43-47). It would have been obvious to a person of ordinary skill in this art at the time of the invention to apply the teachings of Cook to the Seehase recoil pad and have a recoil pad with a different type of plastic plate material.

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8. Claims 1-2 and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Cook.

Cook discloses a recoil pad comprising:

- a) a plastic base; 12; col. 6, lines 1-2
- b) a rear member of deformable material (polyurethane gel); 16; col. 4, lines 3-9
- c) said rear member has a deformability that can vary cols. 3 and 4
according to degree of absorption of the recoil energy;
- d) an outer protective coating applied to the outer surface; and 18
- e) a fixing means. col. 3, lines 65-67

With regard to claims 4 and 5, note that claim limitations directed to the way in which an article is made are not limiting in the confines of an apparatus claim.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cook in view of Beretta 935.

Cook applies as previously recited. However, undisclosed is a fixing means that is a snap-acting fixing means. Beretta 935 teaches a fixing means that is a snap-acting fixing means 16, 17. Applicant is substituting one fixing means for another as explicitly encouraged by the primary reference Cook (see col. 3, lines 65-67 of Cook). It would have been obvious to a person of ordinary skill in this art at the time of the invention to apply the teachings of Beretta 935 to the Cook recoil pad and have a recoil pad with a different type of fixing means.

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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11. Claims 1-2 and 4-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Beretta (EP 507 A2).

Beretta (EP 507 A2) discloses a recoil pad comprising:

- a) a plastic base; 14a, 14b,
- b) a rear member of deformable material (polyurethane gel); 13; paragraph 21
- c) said rear member has a deformability that can vary paragraph 21
according to degree of absorption of the recoil energy;
- d) an outer protective coating applied to the outer surface; and 12; paragraph 20
- e) a fixing means. 16, 17

12. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beretta (EP 507 A2) in view of Cook.

Beretta (EP 507 A2) applies as previously recited. However, undisclosed is a plastic base plate that is a polyurethane gel. Cook teaches a plastic plate that is a polyurethane gel 16. Cook explicitly encourages substituting one material type for another in an analogous art setting (see col. 4, lines 43-47). Beretta (EP 507 A2) explicitly encourages substituting different materials types for his plastic or TP polyurethane base plate 14 (see paragraph 22). It would have been obvious to a person of ordinary skill in this art at the time of the invention to apply the teachings of Cook to the Beretta (EP 507 A2) recoil pad and have a recoil pad with a different type of plastic plate material.

13. Claims 8-11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. Johnson whose telephone number is 703-306-4158. The examiner can normally be reached on Tuesday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 703-306-4198. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-4177.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9326. The fax phone number for after final communications is (703) 872-9327.



STEPHEN M. JOHNSON
PRIMARY EXAMINER

Stephen M. Johnson
Primary Examiner
Art Unit 3641

SMJ